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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Frank Venegas JR.

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EXAMINER

CANFIELD, ROBERT

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

10/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/779,782	Applicant(s) VENEGAS, FRANK	
	Examiner ROBERT J. CANFIELD	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-9, 11, 15, 16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16, 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 4-9, 11, 15, 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. This Office action is in response to the amendments filed 03/30/10 and 07/14/10.

Claims 4-9, 11, 15, 16, and 18-22 are pending. Claims 1-3, 10, 12-14 and 17 have been canceled.

2. The new drawings filed 03/30/10 are accepted.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no written description of the cover being molded of a rigid or semi-rigid molded plastic. The language "rigid or semi-rigid" is not found in the original disclosure. The only description of the material begins at line 21 of page 5 and continues to line 8 of page 6 where the material has been defined as "a resilient, durable, and exposure resistant structural plastic that includes materials such as low-density polyethylenes and LEXAN brand polycarbonate". A plastic that is "rigid or semi-rigid" is considered to be of different scope than structural plastic and not fully supported by the original disclosure. There is no standard

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provided as to what is included or excluded by "rigid or semi-rigid". While structural plastic may be rigid or semi-rigid, all rigid or semi-rigid plastics are not necessarily structural plastics.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4-7, 9, 15, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 4-7 the preamble "the barrier cover" fails to agree with the preamble of claim 19 from which the claims depend rendering the intended scope of the claims unclear. Further, in claims 4-7 "the advertising display" lacks antecedent basis. Note that the advertising display was not introduced until claim 21.

In claim 9, "each side panel" lacks antecedent basis.

The preamble of claim 15 fails to agree with that of claim 11 from which claim 15 depends rendering the intended scope of the claim unclear.

The preamble of claims 20 and 21 fail to agree with that of claim 19 from which claims 20 and 21 depend rendering the intended scope of the claims unclear.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 8, 9, 11 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,874,103 to Muta.

With respect to claims 8, 9 and 22, Figure 6 of Muta provides a cover 24 of structural plastic having spaced apart front and back panels each having a semi-circular upper portion and a corresponding bottom edge having an open slot 28. As shown in the figures an arc-shaped side panel joins all edges except the bottom edges of the front and back panels. The cover is capable of being placed over and corresponding to a tubular metal guard rail.

With respect to claim 11, Muta further provides that an advertising display 10 can provide with the back panel of the cover and a fastener 18 is provided which is capable of fastening the cover to a guard rail.

9. Claim 16, 18 and 19 are allowed.

10. Claims 4-7, 15, 20 and 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or adequately suggest the semi-circular side

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edge corresponding to the tubular metal guard rail or the outer diameter of the tubular metal guard rail.

12. Applicant's arguments filed 03/30/10 have been fully considered but they are not persuasive. The affidavit under 37 CFR 1.132 filed 3/30/10 is insufficient to overcome the rejection of claim 22 based upon 35 U.S.C. 112 first paragraph as set forth in the last Office action because:

Applicant argues that the language "rigid or semi-rigid" is supported by the original disclosure because the original specification discloses the use of "structural plastic" which any person skilled in the art would recognize as being "rigid or semi-rigid". This is not found persuasive because while structural plastics such as low density polyethylenes and LEXAN may be considered rigid or semi-rigid plastic, all rigid or semi-rigid plastics are not necessarily structural plastics. Thus the language of the claims is not fully supported by the original disclosure. Applicant very well could have used the language "structural plastic" in the claims, which has support in the original disclosure.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. CANFIELD whose telephone number is (571)272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rich Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield
Primary Examiner
Art Unit 3635

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Primary Examiner, Art Unit 3635